

REMARKS

The application now contains claims 55-58, 61-63, 65-67, 69-71, 73-75 and 77-82.

In the above referenced office action, the Examiner rejected claims 54-58, 61-63, 65-67, 69-71 and 73-75 under 35 U.S.C. §103(a) as being unpatentable over Fitzgerald in view of Kydd et al., Japanese Patent 4183804A and Tsubuko, et al.

This amendment is filed in response to a final office action dated February 28, 2003 and in conjunction with a concurrently filed Request for Continued Examination.

Claim 54 has been cancelled and claim 55 has been put in independent form. In addition, the claim has been amended so that the toner particle is adapted for use in electrostatic image formation.

The Examiner's rejection is based on his finding that "It is noted that flakes are not defined by either size and can be any metal containing particle containing metal that reflects light." Aside from the missing word after "either", the Examiner has essentially found that a round particle is a flake. This, however, is not the usual association of the word flake, which is defined in Webster's Encyclopedic Unabridged Dictionary as "a small, flat, thin piece." A copy of the page containing the definition is submitted herewith.

Fitzgerald was described in the response to the previous action and is not repeated here. The Examiner states that "Fitzgerald teaches a novel powder that can be used as a toner having reflective flakes". However, as indicated in the previous office action, Fitzgerald does not provide a toner particle *adapted* for electrostatic image formation. This is a requirement of the claim and according to both the Board of Appeals and the Federal Circuit it represents structure that must be considered. This is especially true in the case of Fitzgerald, which is not even capable of such use. The Examiner has not considered this factor.

Kydd was also described in the response to the previous action. In Kydd each single flake is coated with a coating material that is not a polymer. The Examiner's statement that "Kydd et al. teaches metallic toner particles in which a silver flake...can be utilized in a toner composition" does not address the limitations of claim 54, which requires that there be flakes of metal dispersed in a polymer. Kydd does not have flakes of polymer dispersed in a polymer, or in anything else, for that matter. Again the Examiner does not appear to have considered this factor.

Japanese patent 4183804A was also discussed in the response to the previous action. As is clearly shown in the abstract that was originally filed and in the two abstracts enclosed, the reference discusses a polymer particle that is coated with metal, for example by electroplating. This is completely different from a polymer that has flakes of metal dispersed inside the polymer.

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Applicants see no relevance whatsoever of this reference to the present claims. Applicants submit that the statement of the Examiner that the Japanese patent teaches "the coating of a metallic particle with a resin composition" is incorrect. Even a cursory reading of the abstract shows that the opposite is the case.

The Tsubuko reference is described by the Examiner as being relevant since it teaches "the coating of a metallic particle with a resin composition". Applicants respectfully submit that the Examiner is in error. This reference utilizes a variety of black and colored pigments. However, none of these pigments is a metal, either in flake or any other form. Applicants further point out that even if the reference did teach what the Examiner indicates that it teaches, there would not be any relevance to the present claims which require dispersion of metallic flakes in a polymer.

In an IDS filed earlier in this case, applicants submitted copies of abstracts of JP 5242721 and JP 4101156. Applicants submit herewith a copy of the drawings of each of these references together with a machine translation of the JP 5242721 reference. Since applicants were unsure of the import of these references, a Japanese associate was asked to determine if the references taught the use of flakes dispersed in the polymer or not. Copies of the questions asked and his answers are also appended.

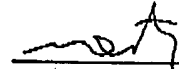
As is clear from the present submissions, these references teach the use of very small flaky powder for the production of printed circuit boards by electrophotography. In these references the flakes are described as having an average size of 0.4 or 0.5 micrometers. Claim 55, utilizes flakes that are larger than 4 micrometers in extent. Such large flakes provide a toner, if they are aligned on the substrate on which they are printed, with a high specular reflection (page 15, lines 14-18 of the present application). There is no hint in either JP 5242721 and JP 4101156 of any decorative use and thus no impetus for providing any larger flakes which give the high specular reflection of claim 54.

Applicants submit that the present claims are patentable over the cited art. Notice to this effect is respectfully awaited. If the Examiner has any questions, he is respectfully requested to call Dr. Paul Fenster at 1 (877) 428-5468. Please note that this is a direct *toll free* number in the US that is answered in the undersigned's Israel office. Israel is 7 hours ahead of Washington.

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In the event that the Examiner continues his rejections under the art cited, he is respectfully requested to provide reasoning as to motivation for combining and how, technically, based on the references a combination is possible and obvious in order to produce the claimed invention.

Respectfully submitted,
Benzion LANDA, et al.



Maier Fenster
Reg No. 41,016

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William H. Dippert, Esq.
Reed Smith LLP
599 Lexington Avenue, 29th Floor
New York, NY 10022-7650